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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,172	05/19/1999	HIROKI KANNO	016907/0967	4798

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FOLEY & LARDNER
SUITE 500
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WASHINGTON, DC 200075109

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/27/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/314,172

Applicant(s)

KANNO ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/11/03, and has been entered and made of record. Currently, **claims 19-25** are pending.

Response to Arguments

2. Applicant's arguments filed 6/16/03, with respect to newly added **claim 19**, which incorporates the limitations of the now canceled claims 1 and 9, have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the newly added **claim 19**, which incorporate the now canceled claims 1 and 9, which the examiner notes were rejected in the previous Office action dated 3/13/03, as being unpatentable over Uda *et al.* (U.S. Patent Number 5,822,507) in view of Aoyama (U.S. Patent Number 5,361,141), which state on pages 5 and 6, that Aoyama fails to suggest synthesizing first image data with second image data and then forming the synthesized data on an image forming medium, as Aoyama teaches of displaying overlapped data on a screen as opposed to an image formation medium. The examiner notes that "an image formation medium" can be interpreted by one of ordinary skill in the art to be a display screen, since it is a medium that forms an image. Thus, Aoyama teaches of a synthesizing means (column 1, lines 10 through 47, and column 4, line 39 through column 5, line 14) that synthesizes the first image data obtained by the image processing means with the second image data produced by the operating condition image producing means (being the edit area and

content, which is produced by the edit pad 15, column 5, line 47 through column 6, line 23) and provides resultant synthesized image data in a case where the designating means designates synthesis and provides only the first image data obtained by the image processing means in other cases (Fig. 3(a)-3(i), column 6, line 55 through column 7, line 46). Therefore, it would have been obvious to a person of ordinary skill in the art to include Aoyama's teachings of a synthesizing means in Uda's system, since both Uda and Aoyama teach of the second image data being for determining, enhancing, and correcting the image quality of the first image.

3. Therefore, the rejection under 35 U.S.C. 103(a), as being unpatentable over Uda *et al.* in view of Aoyama, is maintained for newly added claim 19, with a full discussion appearing below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 19-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Uda *et al.* (U.S. Patent Number 5,822,507, cited in the Office action dated 3/13/03) in view of Aoyama (U.S. Patent Number 5,361,141, cited in the Office action dated 3/13/03).

Regarding **claim 19**, Uda discloses an image forming apparatus (Fig. 1) comprising means (scanners 103a and 103b) for reading a document and providing image data on the document as first image data (column 4, lines 8 through 12), means (scanner print server 102) for

processing the first image data provided by the reading means (column 4, lines 8 through 65), means (printers 104a-d) for forming an image on an image formation medium corresponding to input image data (column 3, line 52 through column 4, line 12), means for producing image data as second image data (server process 107), indicative of at least one of operating conditions which determine image quality of the reading means, the image processing means and the image forming means (column 11, lines 4 through column 12, line 47), means for controlling the image forming means (host computer 101) to form an image corresponding to the first and second image data synthesized by the synthesizing means on the image formation medium (Figs. 1-6, 14-20, Abstract, column 2, lines 35-49, column 3, line 35 through column 5, line 17).

However, Uda fails to specifically teach of a synthesizing means for synthesizing the first image data processed by the image processing means with the second image data, and of a means for designating whether or not the first image data obtained by the image processing means should be synthesized with the second image data produced by the operating condition image producing means, and if the synthesizing means synthesizes the first image data obtained by the image processing means with the second image data produced by the operating condition image producing means and provides resultant synthesized image data in a case where the designating means designates synthesis and provides only the first image data obtained by the image processing means in other cases. Aoyama discloses an image forming apparatus (Fig. 2) comprising reading means (IIT 25) for providing a first image data (column 5, lines 15 and 16), image processing means (IPS 26, column 5, lines 15 through 22), image forming means (display 19 and IOT 27, column 5, lines 15 through 35), operating condition image producing means (edit pad 15) for producing a second image data (editing instructions, column 5, line 47 through

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column 6, line 23), synthesizing means for synthesizing the first image data processed by the image processing means with the second image data (column 1, lines 10 through 47, and column 4, line 39 through column 5, line 14), means (CPU 11) for controlling the image forming means (display 19) to form an image corresponding to the first and second image data synthesized by the synthesizing means on the image formation medium (Figs. 1b and 3, column 4, line 39 through column 6, line 7, column 6, line 55 through column 7, line 39). Further, Aoyama teaches of means (keyboard switch interface 16 and mouse 22) for designating whether or not the first image data obtained by the image processing means should be synthesized with the second image data produced by the operating condition image producing means (column 5, line 36 through column 6, line 54), and the synthesizing means synthesizes the first image data obtained by the image processing means with the second image data produced by the operating condition image producing means and provides resultant synthesized image data in a case where the designating means designates synthesis and provides only the first image data obtained by the image processing means in other cases (Fig. 3(a)-3(i), column 6, line 55 through column 7, line 46). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Aoyama's teachings in the system of Uda. Uda's system would easily be modified to incorporate Aoyama's teachings, since both Uda and Aoyama teach of the second image data being for determining, enhancing, and correcting the image quality of the first image.

Regarding *claims 20 and 21*, Uda and Aoyama disclose the apparatus discussed in claim 19, and Uda further teaches that the operating condition image processing means includes means for producing a character image data and a pattern code image data indicative of the operating

conditions (column 1, line 59 through column 2, line 22, column 12, lines 31 through 51, and column 19, line 55 through column 20, line 44).

Regarding **claim 22**, Uda and Aoyama disclose the apparatus discussed in claim 19, and Uda further teaches that the operating condition image processing means includes means for producing an image data indicative of input conditions of the reading means (column 1, line 59 through column 2, line 22, column 12, lines 31 through 51, and column 19, line 55 through column 20, line 44).

Regarding **claim 23**, Uda and Aoyama discloses the apparatus discussed in claim 19, and Uda further teaches that the operating condition image processing means includes means for producing an image data indicative of a resolution and sampling rate of the reading means (column 1, line 59 through column 2, line 22, column 12, lines 31 through 51, and column 19, line 55 through column 20, line 54).

Regarding **claim 24**, Uda and Aoyama discloses the apparatus discussed in claim 19, and Uda further teaches that the operating condition image processing means includes means for producing an image data indicative of output conditions of the image forming means (column 1, line 59 through column 2, line 22, column 12, lines 31 through 51, and column 19, line 55 through column 20, line 44).

Regarding **claim 25**, Uda and Aoyama discloses the apparatus discussed in claim 19, and Uda further teaches that the operating condition image processing means includes means for producing an image data indicative of processing conditions of the image processing means (column 1, line 59 through column 2, line 22, column 12, lines 31 through 51, and column 19, line 55 through column 20, line 44).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

Edward L. Coles
EDWARD COLES
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jrp